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Applicant: Rolf Carlson, Ph. D.

Serial No.: 08/959,575

Filed: October 28, 1997

Title: "SYSTEM FOR SUPPLYING SCREENED
RANDOM NUMBERS FOR USE IN
RECREATIONAL GAMING IN A CA-
SINO OR OVER THE INTERNET"

Group
Art
Unit:

2767

Our docket: xRCa-03

Examiner
Douglas Meislahn

AMENDMENT

Hon. Commissioner of Patents
and Trademarks
Washington, D. C. 20231

Sir:

This is responsive to the
Official Action of December 20.

I hereby certify that this correspondence is being deposited as
first-class mail in an envelope addressed to the Commissioner
of Patents and Trademarks, Washington, D. C. 20231, on

February 20, 2001

Peter I. Lippman
Peter I. Lippman, Registration 22,835

REMARKS

Applicant thanks Examiner Meislahn for having withdrawn
earlier rejections based upon enablement. Applicant also

thanks the Examiner for having responded very specifically to the Applicant's previously presented reasoning. For reasons stated in the following pages, the Applicant respectfully traverses the remaining grounds of rejection.

Section 112 Definiteness

In the Action it is said that the word "substantially" as used in the claims lacks a requisite standard. This simply cannot be so, however, when the record of this prosecution already contains four specific examples of operation that demonstrate the bounds of the word "substantially".

File-wrapper estoppel prevents application of the claim language beyond the demonstrated bounds. Hence a requisite standard is provided.

The Official Action seems to suggest that caselaw must expressly mention "nefarious behavior" to authorize precautions against it. Designing around claims is a recognized international pastime, and the Applicant submits that all caselaw imposing less than a rigid requirement of claim-lan-

guage literalism thus authorizes precautions against nefarious behavior.

The Manual of Patent Examining Procedure presents examples that suggest what is really meant by "lacks a requisite standard" — and also cites decisions which offer more of the flavor of this concept:

"II. 35 U.S.C. 112, SECOND PARAGRAPH

Defects in claim language give rise to a rejection of the claim under the second paragraph of 35 U.S.C. 112. Typical examples include . . . [u]se of phrases in the claim such as "substantially as shown," "or similar article," "or the like," or equivalent terminology. Ex parte Sussman, 8 USPQ2d 1443 (Bd. Pat. App. & Inter. 1988); Ex parte Pappas, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992)."

Even before looking at the cases, it is immediately clear from the examples themselves that their level of indefiniteness is significantly greater than what is found in Applicant's claims.

The first MPEP example is "substantially as shown" (emphasis added), plainly referring to an invention. This is an entirely different matter from Applicant's use of "substantially" to surgically and slightly modify a

characteristic of an identified element in a claim that runs to many lines.

Thus in that first example the general character of the entire invention is very open ended. It is fair to say that a person wanting to compete in the marketplace would be inadequately placed on notice of the boundaries of infringement.

The second example in the MPEP is "or similar article" (emphasis added), which even more explicitly goes to the general character of an entire article — and again, please notice, to its general character in the sense that the word "similar" is not even applied to any particular characteristic of the article. Thus a would-be legitimate competitor cannot determine whether s/he must avoid similarity of color, shape, weight, frequency, dynamic range, radiation level, or energy yield upon combustion.

The last MPEP example, "or the like", also goes to what is "similar" to some thing or "like" some thing — but without specifying any limits as to which aspect or behavior of that thing is to be thus open ended. In comparison with all these three examples, Applicant's claim by comparison is the very model of specificity:

it is the size of each pseudorandom number that is "substantially" not limited to any specific number of digits or places,

it is the sequential sets of raw numerical values that are "substantially" long-term random or pseudorandom,

it is the supplying of verified sets whose "each-ness" is "substantial" — *i. e.*, what is supplied is substantially "each" as contrasted with "some" or "most" or "a few", and

it is the provision of the sets that is "substantially" continuous.

Nevertheless it is interesting and further helpful to consider the cited cases. Such consideration reveals that both Sussman and Pappas were design cases: the claims as presented by the applicants were, respectively:

"The ornamental design for a serving tray substantially as shown and described"; and

"The ornamental design for a feed bunker
... or similar structure as shown
and described".

In this context it can now be seen as even more devastating to definiteness that the questioned terminology was applicable to entire articles, inventions, or things. The "substance" (and therefore the sweep of a word such as "substantially") of a design — its esthetics, and its overall impact — is wholly ephemeral in comparison with the characteristics or even the general nature of utility-patent subject matter.

This is not to suggest that the examples given in the MPEP would be acceptable in utility-patent cases. Filing of a utility-patent claim that reads in its entirety, "The device shown and described" has been recognized (for perhaps more than a century) as a reliable technique for preventing an undesired allowance on first action.

The Pappas case expressly states that on this issue its own precedents (and it cites several) are utility-patent cases. A full discussion therefore requires consideration of at least some of those:

In *Ex parte Kristensen*, 10 USPQ2d 1701 (BPAI 1989), the issue related to the phrase "or similar apparatus" — and

thus once again went to indefiniteness about a whole apparatus, as in the other example cases. (The only odd twist here was the question whether such language might be permissible in preamble.)

In *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948), although there were several different disputes about indefinite language (including such amusements as an objection to the word "space" defined as an affirmative element) no language such as "similar", "substantially" etc. was found in the case. Evidently the citation from *Pappas* was as a matter of generic indefiniteness and not actually related to "substantially".

In *Ex parte Steigerwald*, 131 USPQ 74 (Bd. App. 1961), and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949), the disputed language was "such as" or "such, for example, as" — much less definite than the usage in the present case. Hence all of the MPEP-track cases involve considerably less-definite usages than the "substantially" occurrences here.

The court in *Pappas* said, "Although all of these cited cases involve utility applications rather than design applications, the effect of the language in question is the same in that it obscures the metes and bounds of the claimed design." Thus the overall question, in perspective, becomes

not whether absolute definiteness is required but rather how much definiteness is required.

In addition to cases traced above from the MPEP, a collection of cases on terms such as "substantially" appears in the current edition of Chisum on Patents — at volume 5A, section 18.07[2], footnote 7. Without setting out that entire (lengthy) note here, two excerpts may be worthwhile:

Validating the undersigned's original proposition on this issue is a passage from Dippin' Dots v. Mosey, 44 USPQ2d 1812, 1815-16 (N.D. Tex. 1997): "Words such as 'substantially,' 'approximately,' and 'about' are often used in claims to prevent a potential infringer from avoiding literal infringement by making a minor modification." (emphasis added)

From Mickowski v. Visi-Trak Corp., 36 F. Supp.2d 171, 178-79 (S.D. N.Y. 1999): "The term 'substantially' is a term of art used by the drafters of patent claims and must be interpreted in light of the specification and prosecution history. In this case, it is clear that the term 'substantially' has been included merely to bridge the gap between the abstract description of a method and its practical application in the real world. . . ."

Section 103 rejections

(a) Systematic testing of every set — The Official Action near top of page 3 addresses Applicant's earlier comment that the adduced prior art "is lacking a 'systematic testing of substantially every set of numbers.'" The Action responds: "This deficiency is remedied by the inclusion of the other references."

Applicant is grateful for this concession that there is indeed a deficiency; however, the deficiency is not remedied by the other references — if they fail to prove what the Action says they prove, or in the aggregate they fail to come up to the invention, or if they are improperly in the case or not combinable. Those are the primary thrusts of the reasoning presented in Applicant's September response as well as the present one.

(b) Wilke is nonanalogous art — In paragraph 6 of the Action, citation is made to the *Oetiker* decision for standards of reasonable pertinence, and the Wilke reference is said to be "concerned with random number generation in a gaming environment." In the present context, both these points are faulty:

The Oetiker case went against the PTO, and is illuminating for ways in which hindsight can lead astray. Oetiker's invention was a metal hose clamp for use on an assembly line, and had a special hook for use in preassembling certain parts together, before final fastening of the parts. The hose clamp and hook had nothing to do with garments, but as the Federal Circuit recounted:

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem . . . of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. Indeed, the argument is not supportable.

What the court was criticizing here was a form of circular reasoning, or perhaps it should be called double-backward or "hairpin" reasoning, in which the invention (hose-clamp hook) could have been exported to a nonanalogous article (garment). Therefore, the reasoning continued, a person — including an examiner — in the field of the invention (hose-clamp hooks)

could resort to the nonanalogous field (garments) for a suitable hook.

While this specific type of reasoning may not appear in the present case, it was not the only suspect type taken up in *Oetiker* — where the Federal Circuit went on:

However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does *Oetiker's* invention.

The Board apparently reasoned that all hooking problems are analogous. At least, that is the argument now pressed by the Commissioner. (emphasis added)

Needless to say the court found this argument wanting.

The specific reason it was wanting is that it too was circular, though not hairpin. It proceeded in reverse from the arguer's desired conclusion — namely that a hook was needed and luckily a hook was available — to the necessary premise, namely that divergent specific fields of endeavor can be simply washed away in event they are inconvenient.

This is a form of presupposed conclusion, derived through hindsight. Thus the question of what is "reasonably pertinent to the particular problem with which the applicant was concerned," as introduced in paragraph 6 of the present

Official Action, is not one which can be sweepingly answered in any simple way — but rather requires cautious evaluation of the problems presented, and the people working, in the arts that are involved.

Turning to the second point in paragraph 6 of the present Official Action, it is there said that "Wilke is concerned with random number generation in a gaming environment." With respect, this statement is in error.

Wilke is about a game, but not about gaming. The word "gaming" in this case — as correctly stated at paragraph 14 of the Action — refers to gambling for money in casinos and via remote networks. This is a very different field, most typically involving very different personnel from those who design arcade games, pinball machines and video games for skilled competitive play for the cost of a coin — with no prospect whatever of a jackpot.

Why then does Wilke's arcade-type football-simulating game have random-seeming numbers at all? (We agree, I believe, that they are not really random in any meaningful mathematical or generation-based sense — so Wilke does not belong in the same basket with Vasseur either.)

Wilke says clearly that the "random" numbers merely select which of several possible outcomes may result from a

player choosing to "punt", for instance, or to "pass" — thus simulating an aspect of play in a football game. In the real game, when the quarterback elects a particular such strategy, he is deprived of foresight that might reveal the effectiveness of its execution (not to mention of the defense); Wilke uses random-seeming numbers to simulate that deprivation.

This deficiency (not a gaming patent) of Wilke tallies fatally with the conceded deficiency in the Applicant's adduced art. Thus "the other references" (Wilke, for one) cannot remedy the deficiency in the adduced art, because Wilke does not belong in this case.

The Oetiker court would say, if it got its hands on this case, "The Patent Office apparently reasoned that all play-machine problems are analogous." Applicant therefore again respectfully requests withdrawal of rejections based on Wilke in a combination with either the adduced art or Vasseur.

In regard to suggestion and motivation the Official Action also cites to In re Fine, and In re Jones. *Fine* is about gas chromatography with a focus on the chemistry of the analytes, and *Jones* is another heavy-duty pharmaceutical case.

Both were decided based upon fine chemical/biochemical issues, and accordingly neither case is readily analogized to

the present one. It is fair to say, however, that both were decided quite tartly, and against the patent office.

(c) References CAN be attacked individually — In paragraph 7 of the Action, it is argued that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references" (citing *Keller and Merck*). With respect, this statement is one of those patent-law truisms that are blatantly not true.

References are individually attackable (1) on the points for which they have been cited, as well as (2) their combinability, and (3) their basic presence in a case, and particularly (4) whether they contribute to the combination in such a way that the aggregate will come up to the claimed invention. Furthermore in the present case these points can be and have been demonstrated by reasoning through (if not "attacking" as the Official Action puts it) the references singly, because that is virtually the only way to discuss complicated things, i. e. one at a time.

That is exactly the basis of the Applicant's previous reasoning directed to the references:

- Since Wilke is incompatible with both Vasseur and the adduced gaming art, Wilke cannot link Vasseur and the

adduced gaming art to each other — and earlier in the prosecution of this application it has been established that Vasseur cannot itself link directly to the adduced gaming art.

- Since Vasseur alone cannot teach what statistics to apply and when, and since the adduced gaming art cannot teach that — and Wilke certainly comes nowhere near anything of the kind — then the combination of references cannot come up to the invention.

The Official Action cites to *Keller* and *Merck*. These decisions, however, are not helpful to the positions espoused in the Official Action:

Keller was about cardiac pacemakers, and the issue was whether a lab-tool investigatory pacer (the "Walsh et al article") could be combined with real operative pacer art. The CCPA said:

As characterized by appellant, the Cywinski affidavit offered as objective evidence . . . of non-obviousness "concerns itself mainly . . . with the question of whether the Walsh et al article [suggests] the use of digital timing in a cardiac pacer. . . ." But one cannot show non-obviousness by attacking references individually where, as here, the

rejections are based on combinations of references.

Yet the CCPA itself elsewhere at length discusses Walsh alone, so the comment about attacking references individually is plainly to be understood as only having limited applicability. What it really means is that nonobviousness cannot be shown by — in the last analysis, at the bottom line, and at the end of the day — defeating less than the whole combination.

There is also a lesson in *Keller* about nonanalogous arts. Since the Official Action in the present case cites *Keller*, and since nonanalogous art is an issue in the present case, this point will be included:

Appellant "strongly emphasizes" that Walsh "is not about cardiac pacing"; and that the device taught by Walsh is an . . . investigatory device used in the study of a mammalian heart rather than a therapeutic device used in the treatment of a living human (which, of course, has a mammalian heart).

Walsh discloses a heart stimulator used in studies of the atrioventricular conduction system of a mammalian heart. A stimulator used in studies of the atrioventricular conduction system of a mammalian heart is not so non-analogous

to a . . . stimulator used to pace a mammalian heart that it should be ignored. Accordingly, Walsh may be combined with either Keller or Berkovits. In re Menough, 51 CCPA 741, 323 F.2d 1011, 139 USPQ 278 (1963).

Appellant further argues that Walsh does not relate to a cardiac pacer because Walsh teaches a stimulator which is used in conjunction with an oscilloscope, and which has a multiplicity of multiple position switches that are operator controlled. As discussed above, Berkovits discloses a cardiac pacer which may be used in conjunction with an oscilloscope, and which has a multiplicity of multiple position switches as well as other variable circuit elements that are operator controlled. Thus, the argument that such features render Walsh unrelated to a cardiac pacer is without merit.

As will be clear, the devices involved in Keller were in fact all heart pacemakers, though some took a form used in the lab for research and some were particularly intended for use with animals. It is believed clear that the devices involved in the present case are much more remote from one another than those in Keller — one group being gambling systems, another device being an arcade game or pinball-type machine, and yet another being a random-number generator.

when there has been established some motivation or suggestion "to do so". Then, however, having said that, the Action goes on to say, "In this case, Wilke teaches the desirability of short random sets of numbers" — as if that discharged the obligation to find a motivation or suggestion "to do so".

The problem here is that "motivation to do so" means "motivation to combine the references", not merely motivation to use the particular feature which it is desired to import into the combination. In this case it appears that Wilke's proposed function in the proposed combination is to interlink the adduced prior art with Vasseur, and thereby to teach desirability of using Vasseur's random numbers in the adduced art.

There is no really effective suggestion or motivation, however, to combine Wilke with either Vasseur or the adduced art. He is perhaps comparably distant from both, yes — but still distant.

If there were such a suggestion, then it might be meaningful to speak of Wilke's teaching "desirability of short random sets of numbers" for use in the adduced art. Without such a suggestion, the Oetiker court can now say again (paraphrasing of course), "The Patent Office apparently reasoned

The Merck case deals with very advanced pharmaceutical subject matter, and is therefore much more difficult to understand and to use as guidance in the present matter. It does perhaps shed some light on the fundamental point of the "attacking references individually" rubric under discussion:

We also find untenable appellant's arguments that Petersen teaches away from appellant's invention. Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of . . . references. In re Keller Thus, Petersen must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.

This last observation is believed to be a much more useful and constructive way to formulate the "attacking references singly" idea. Applicant respectfully submits that his reasoning has in fact satisfied this formulation.

(d) The required suggestion/motivation is to COMBINE, not to use a particular feature — In paragraph 8 of the Official Action, first a *pro forma* recognition is given to the principle that it is permissible to combine references only

that all randomization problems are analogous." As before, such reasoning is circular, or backward.

(d) Applicant's reasoning goes to the time BETWEEN the references, NOT ONLY to their "MERE age" — In paragraph 9 of the Official Action it is said:

"contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references." (citing *Wright*)

What the *Wright* case actually says, however, is "the mere age of the references" — and the Applicant's previously presented reasoning goes not only to "mere" age but rather to the relationships between the references, and also to the question of what is meant by the "problem".

In the previous response, the Applicant specifically observed first that —

"Wilke's device was published in the 1970s, and Vasseur's RNG invention in the 1960s. This means:

- (1) Wilke himself must be charged with knowledge of Vasseur, published a half-decade before Wilke filed, and

if the combination were obvious
then Wilke himself would have
perceived and mentioned it"

This is not only a "secondary considerations" line of reasoning, but something more. It must be appreciated that Wilke is not just a person of ordinary skill in the art, but rather a person of greatly elevated visionary status, relative to ordinary skill — namely, a credentialed inventor, i. e. a patentee. Furthermore he must be charged with knowledge of Vasseur.

Therefore if there were some significant advancement to be gleaned from considering Wilke's and Vasseur's inventions in combination together; and if they were in analogous arts, then Wilke should necessarily have noted this, long before any person of just ordinary skill. Yet Wilke's patent evidences no such thought, and this failing tends to suggest that in fact they are in nonanalogous arts, or that no such combination was obvious whether the arts be deemed analogous or not — or both.

In this reasoning, Wilke serves both as an inventor contributing his own innovations, and as a representative test person in at least his own art. If he saw nothing obvious to

combine as between himself and Vasseur, then it is fair to conclude that there was nothing.

Applicant's analysis in his previous response, however, went on further, saying —

(2) both references have been available to the skilled artisan and inventing public for more than twenty years now, but prior art combining them does not seem to be available in the present prosecution.

The cited Wright decision does say, "The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem." This holding is good in the circumstances of *Wright* but not necessarily in all circumstances.

In particular it is not good if there is more than just "mere" age of the references, as here: the present invention has not been rejected as lacking utility, and it has not been suggested that the utility which it has is a new development.

Certainly the gaming (casino gambling) industry has been very healthy for at least many decades, and exercise of the present invention in that industry is potentially extremely

profitable — as the present application suggests.

Furthermore there is no suggestion here that the technological infrastructure that enables the invention is new.

Hence it may be reasonably said that the opportunity to bring forth this utilitarian invention has existed for some long while. "The problem" is simply failure to recognize and exercise this opportunity.

Somewhat analogously, note that in Eibel Process Company v. Minnesota & Ontario Paper Company, 261 U.S. 45; 43 S. Ct. 322 (1923), the Court held that invention could consist of the discovery of the source of a problem, even when the solution to the problem involved a slight and simple change.

Thus in our present situation we need not decide whether the art "tried and failed to solve the problem" or the art just "failed to recognize the existence of the problem" (i. e. the opportunity). If it was so obvious, then why has it been left to the Applicant to first propose it?


The answer is that it is not obvious.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner's favorable reconsideration and allowance of the claims now standing in this case.

It is respectfully requested that, should there appear any further obstacle to allowance of the claims herein, the Examiner telephone the undersigned attorney to try to resolve the obstacle.

Respectfully submitted,


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February 20, 2001

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February 20, 2001

Commissioner of Patents
and Trademarks
Washington DC 20231

RE: U. S. utility-patent application 08/959,575
filed October 28, 1997
of Rolf Carlson, Ph.D.
for: "SYSTEM FOR SUPPLYING SCREENED RANDOM
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Respectfully submitted,


Peter I. Lippman
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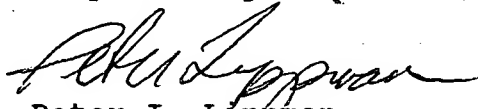
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